

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte LARRY A. SPINO and SCOTT SWANZY

MAY 31 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2005-1280
Application No. 09/610,586

ON BRIEF

Before GARRIS, PAK and KRATZ, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1 through 9, which are all of the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

According to the appellants (Brief, page 2):

The subject matter set forth in this patent application and regarded by [a]ppellants as the invention is a polypropylene composition containing a propylene polymer, an amine oxide, and a clarifying

agent. The composition is "free or essentially free of phenolic antioxidant," which means that no phenolic antioxidant is deliberately added to the instant composition in order to achieve the stabilization (see specification, page 2, lines 7-11) The composition may also contain other additives such as supplemental stabilizers or colorants (see specification, page 6, lines 1-3).

Indeed, the specification at page 2, lines 7-11, states that:

The composition according to the invention is free, or essentially free, of any phenolic antioxidants. In the context of the invention, the phrase "free or essentially free, of phenolic antioxidant" means that no phenolic antioxidant is deliberately added to the instant composition in order to achieve the stabilization.

In other words, the phrase "free or essentially free, of any phenolic antioxidant" does not preclude the presence of any amount of the phenolic antioxidant in the claimed composition so long as it is not deliberately added or it is deliberately added to achieve a purpose other than stabilization. It follows that the phrase in question may limit how the claimed composition is made, but does not limit the chemical or physical aspects of the claimed composition. Moreover, at page 4 of the specification, we note that the appellants define the claimed clarifying agent as including "nucleating agents known for their action on the transparency of the propylene polymers."

The appellants stipulate that "[c]laims 1-9 of the subject patent application stand or fall together." See the Brief, page 3. Therefore, for purposes of this appeal, we select claims 1, 3 and 9 as representative of the claims subjected to the separate grounds of rejection set forth below and determine the propriety of these grounds of rejection based on the representative claims consistent with 37 CFR § 1.192(c) (7) (2003) and 37 CFR § 41.37(c) (1) (vii) (2004). See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002). Claims 1, 3 and 9 are reproduced below:

1. A composition, free or essentially free of phenolic antioxidant, containing
 - a) 100 parts by weight of a propylene polymer,
 - b) from 0.005 to 0.1 part by weight of an amine oxide having the structural formula



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wherein R' and R" are groups containing from 1 to 36 carbon atoms, or of a N,N-dialkylhydroxylamine of a formula

R¹R²NOH (II)

wherein R¹ and R² are independent groups of 1 to 36 carbon atoms,

c) from 0.1 to 0.5 part by weight of a clarifying agent.

3. Composition according to claim 1, wherein the propylene polymer contains from 100 mg to 500 mg of inorganic residue per kg of propylene polymer.

9. Composition according to claim 1 containing:

a) 100 parts by weight of a propylene copolymer containing 0.1 to 5 weight % of ethylene,

b) from 0.01 to 0.1 part by weight of an amine oxide of formula (I) wherein R' and R' are alkyl radicals containing 4 to 22 carbon atoms, and

c) from 0.1 to 0.5 parts by weight of a metallic salt of organic phosphate.

The examiner relies on the following prior art references:

Masino	5,182,341	Jan. 26, 1993
Kobayashi et al. (Kobayashi)	6,238,615 B1	May 29, 2001 (filed Jul. 06, 1999)
Ushioda et al. (Ushioda)	6,410,662 B1	Jun. 25, 2002 (filed May 09, 2000)

McCullough et al. (McCullough) WO 00/12605 Mar. 09, 2000
(Published World Intell. Prop. Org. Application)

The appealed claims stand rejected as follows¹:

- 1) Claims 1, 2 and 5 through 8 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of McCullough and Ushioda;
- 2) Claim 3 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of McCullough, Ushioda and Masino;
- 3) Claims 1 and 4 under 35 U.S.C. § 103(a) as unpatentable over the disclosure of Kobayashi; and
- 4) Claim 9 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Kobayashi and Ushioda.

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and the appellants in support of their respective positions. This review has led us to conclude that the examiner's Section 103 rejections are well founded.

Accordingly, we will sustain the examiner's Section 103 rejections for essentially those findings of fact and conclusions as set forth in the Answer and below.

¹ At page 3 of the Answer, the examiner has stated that "the rejection of [c]laim 3 under 35 U.S.C. [§] 112, first paragraph, is withdrawn" in response to the appellants' Brief dated November 18, 2003.

The appellants do not dispute the examiner's finding that McCullough and Kobayashi teach or would have suggested a propylene polymer composition containing the claimed amounts of the claimed propylene polymer and amine oxide. Compare the Answer, pages 5-6 and 9-10, with the Brief in its entirety. The appellants also do not dispute the examiner's finding that Kobayashi teaches employing a nucleating agent corresponding to the claimed clarifying agent in the claimed amount to form its propylene polymer composition or Ushioda would have suggested employing the claimed clarifying agent (nucleating agent) in the propylene polymer composition taught by McCullough.² Compare the Answer, pages 6 and 9, with the Brief in its entirety. The appellants only argue that neither McCullough nor Kobayashi teaches or would have suggested a propylene polymer composition "free or essentially free of phenolic antioxidant." See, e.g., the Brief, pages 5-7. According to the appellants (*id.*), the examples in McCullough and Kobayashi are directed to forming a propylene polymer composition containing phenolic antioxidants.

We are not persuaded that the above-mentioned prior art

² McCullough also teaches or would have suggested employing a nucleating additive corresponding to the claimed clarifying agent in a presumably optimum amount to form its propylene polymer composition. See McCullough, page 8.

references would not have suggested a propylene polymer composition "free or essentially free of phenolic antioxidant". When the claimed limitation "free or essentially free of phenolic antioxidant" is given the meaning stated by the appellants in the Brief and the specification as indicated *supra*, it does not preclude the propylene polymer compositions containing a phenolic antioxidant exemplified in the prior art references. In other words, the claimed limitation in question does not distinguish the claimed propylene polymer composition from the propylene polymer compositions suggested by the prior art references. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 965-66 (Fed. Cir. 1985) ("The patentability of a product does not depend on its method of production If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior [art] product was made by a different process").

Even if we were to determine that the claimed limitation in question excludes the presence of a phenolic antioxidant, our conclusion will not be altered. Although the prior art references may exemplify propylene polymer compositions having phenolic antioxidants, they are not limited to those compositions. Substantial evidence supports the examiner's

finding that the phenolic antioxidants disclosed in the prior art references are taught as optional ingredients. McCullough, for example, discloses that "[a]ntioxidants which **may be** most useful in the compositions of the present invention include primary antioxidants of the phenolic-type" (emphasis added). See page 7. Kobayashi also discloses (column 11, line 66 to column 12, line 3) that:

The polyolefin resin composition for use in the present invention **may contain other additives such as stabilizers**, neutralizing agents, antistatic agents, lubricant, etc. These known additives **may be used** in combination, insofar as they are [sic] not adversely affect the effects of the invention. [Emphasis added.]

Thus, we concur with the examiner that the prior art references as a whole would have suggested propylene polymer compositions with or without phenolic antioxidants. See *Merck & Co. v.*

Biocraft Labs, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989) ("the fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered"); *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) (all of the disclosures in a reference, including non-preferred embodiments, "must be evaluated for what they fairly teach one of ordinary skill in the art").

With respect to claim 3, the examiner finds (Answer, page 8), and the appellants do not dispute (Brief, pages 5-6), that:

Since Masino (col. 12, line[s] 15-40) indicate[s] that the preparation of a high melt flow polypropylene [such as that disclosed in McCullough] requires an amount of inorganic catalyst materials for carrying out the polymerization process, Masino (col. 12, line[s] 15-40) clearly indicates that a propylene polymer such as the high melt flow polypropylene of McCullough would also contain a specific amount of inorganic residue.

Implicit in this finding is that the amount of inorganic residue in the propylene polymer composition suggested by McCullough is a function of the optimum amount of the inorganic catalyst used during the production of its propylene polymer. Thus, we concur with the examiner that the prior art references as a whole would have suggested a propylene polymer composition having an appropriate amount of inorganic residue, including that claimed.

See *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990)

With respect to claim 9, the appellants do not dispute the examiner's findings and conclusion set forth at pages 10-11 of the Answer. See Brief, page 7. The appellants only argue that Kobayashi and Ushioda do not teach or would have suggested a

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propylene polymer "free or essentially free of phenolic antioxidant." For the reasons stated *supra*, we are again not persuaded by this argument.

Under the circumstances recounted above, we concur with the examiner that the evidence of obviousness, on balance, outweighs the evidence of nonobviousness proffered by the appellants. Hence, we affirm the decision of the examiner rejecting all of the appealed claims under 35 U.S.C. § 103.

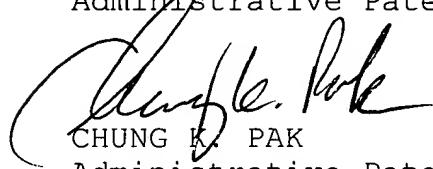
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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

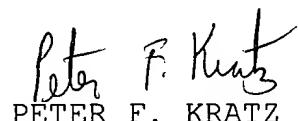
AFFIRMED



BRADLEY R. GARRIS)
Administrative Patent Judge)



CHUNG K. PAK)
Administrative Patent Judge)



PETER F. KRATZ)
Administrative Patent Judge)

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